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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/782,590	01/13/1997	SAMUEL ROSE	43/24	9631

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TUCKAHOE, NY 10707-2208

EXAMINER
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UNGAR, SUSAN NMN

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 07/05/2002

4/8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
08/782,590

Applicant(s)  
Rose

Examiner  
Ungar

Art Unit  
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 2, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 69-87 is/are pending in the application.
- 4a) Of the above, claim(s) 84-87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 69-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. The request filed on August 13, 2001 (Paper No. 35) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/782,590 is acceptable and a CPA has been established. An action on the CPA follows.

2 The Preliminary Amendment filed August 13, 2001 (Paper No. 36) and the Preliminary Amendment filed January 12, 2002 (Paper No. 39) in Response to the Action of October 15, 2001 (Paper No. 38) are acknowledged and have been entered. Claims 69, 71, 72, 75, 77-79 have been amended. Claims 69-83 are pending and currently under examination.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The following rejections are maintained:

***Claim Rejections 35 USC 112***

5. Claims 69-83 remain rejected for the reasons previously disclosed in Paper No.33, Sections 5-9, pages 2-5.

Applicant apparently (a) reargues rejections based on Paper No. 10, Section 5, pages 2-5, and Applicant reiterates arguments recited in Paper No. 14 wherein said arguments are summarized and fully considered in Paper No. 15, pages 2-3, items (a)-(i), (b) reiterates arguments drawn to rejections based on Paper No. 15, Section 5, pages 2-5, and resubmits the Epstein and Rapaport Declarations, wherein said arguments and Declarations are summarized and fully considered in Paper No. 27 (c) Applicant argues, drawn to the rejections based on Paper No. 10, Section 5(b), pages 8-10 that the bispecific reagent can be made by several published

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methods, (d) Applicant reiterates response to Action 5, page 4 (b'), (c') and (d') and Action, Section 6, page 6(a') above in argument drawn to the rejections based on Paper No. 15, Section 6, pages 5-6, (e) Applicant reiterates arguments in "Action, Section 8, page 7" below, (f) Applicant reiterates arguments based on rejections in Paper No. 27, section 7, pages 6-7 wherein said arguments are summarized and fully considered in Paper No. Paper No. 33, (g) Applicant reiterates arguments based on rejections in Paper No. 10, Section 5(c), Page 10 and Section 5(d) page 11 wherein said arguments are summarized and fully considered in Paper Nos. 15 and further summarized and fully considered in Paper No. 27, (h) Applicant reiterates arguments based on rejections in Paper No. 18 (Not 15), Section 8, page 7 wherein said arguments are summarized and fully considered in Paper Nos. 15 and 27, (I) Applicant reiterates arguments based on rejections in Paper No. 27, Section 8, pages 7-8 wherein said arguments are summarized and fully considered in Paper No. 33, (j) Applicant reiterates arguments based on rejections in Paper No. 10, Section 8, pages 6-18 wherein said arguments are summarized and fully considered in Paper No. 15.

The arguments have been considered but have not been found persuasive (a') for the reasons previously set forth in Paper No. 15, (b') the arguments have been considered but have not been found persuasive for the reasons previously set forth in Paper No. 27, (c') Applicant is arguing limitations not recited in the claims as the bispecific reagent is not being claimed, only a therapeutic agent being a soluble precipitable material is claimed, (d') the arguments have been fully considered and are not persuasive for the reasons previously set forth, (f') the arguments are not

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persuasive for the reasons previously set forth in Paper No. 33, (e')(g')(h') the arguments are not persuasive for the reasons previously set forth in Papers Nos 15 and 27, (I') the arguments are not persuasive for the reasons previously set forth in Paper No. 33. Applicant's arguments have not been found persuasive and the rejection is maintained.

***Claim Rejections 35 USC 102***

6. Claims 69-83 remain rejected under 35 UCS 102(b) for the reasons previously set forth in Paper No. 33, Section 8, pages 16-18, Paper No. 15, Section 10, pages 8-9 and Paper No. 27, Section 11, page 9.

Applicant (a) reiterates arguments based on rejections based on Paper No. 10, Section 8, pages 16-18 and paper No. 15, Section 10, pages 8-9 wherein the arguments are summarized and fully considered in Paper Nos. 15 and 27, (b) argues that Section 11 of the Action mailed February 23, 2001 indicates that all other objections and rejections recited in paper No. 27 are withdrawn. The arguments are not persuasive (a') for the reasons previously set forth in Paper No. 15 and Paper No. 27, (b') the relevance of this argument is not understood since claims 69-33 clearly remained rejected in Paper No. 33 for the reasons set forth in Paper No. 27, Section 11, page 9. Applicant's arguments have not been found persuasive and the rejection is maintained.

***New Grounds of Rejection***

***Claim Rejections 35 USC 112***

7. Claims 71-72 are rejected under 35 USC 112, first paragraph, as the specification does not contain a written description of the claimed invention. The

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limitation of a “material” claimed in Claims 71-72 has no clear support in the specification and the claims as originally filed. A review of the specification discloses support for a “chemical” but no support for the broadly claimed “material”. The subject matter claimed in claims 71 and 72 broadens the scope of the invention as originally disclosed in the specification. Applicant is invited to point to page and line number in the specification that provides support for the newly claimed limitation.

8. Claims 77 and those claims dependent upon claim 77 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 77 and the claims dependent upon claim 77 are indefinite because claim 77 is drawn to” a therapeutic agent .....in which each of the indoxyl compounds..... ..move in the extracellular fluids”. The claims are confusing because it is not clear whether it is the attached indoxyl compounds which can move or if it is the therapeutic agent.

9. All other objections and rejections recited in Paper No. 33 are withdrawn.

10. No claims allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

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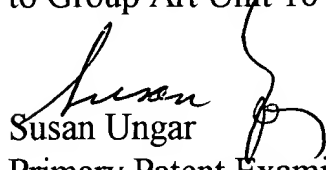
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.



Susan Ungar  
Primary Patent Examiner  
July 3, 2002